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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,313	04/09/2002	Sharon May Armitage	GENS:008US	7941
32425	7590	08/23/2007	EXAMINER	
FULBRIGHT & JAWORSKI L.L.P. 600 CONGRESS AVE. SUITE 2400 AUSTIN, TX 78701			GOLDBERG, JEANINE ANNE	
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/069,313	ARMITAGE ET AL.
	Examiner	Art Unit
	Jeanine A. Goldberg	1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 June 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 33,35,36,38,39,41,44-46,48-52 and 54-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 33,35,36,38,39,41,44-46,48-52 and 54-69 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the papers filed June 5, 2007.
2. Currently, claims 33, 35-36, 38-39, 41, 44-46, 48-52, 54-69 are pending.
3. All arguments have been thoroughly reviewed but are deemed non-persuasive for the reasons which follow.
4. Any objections and rejections not reiterated below are hereby withdrawn in view of the amendments to the claims.
5. This action is FINAL.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 33, 35-36, 38, 41, 44-46, 48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce (US Pat. 2,006,744, 1935) in view of Draper (US 6,007,104, December 28, 1999) and further in view of Ballard (5,709,746, January 1998).

With respect to Claim 36 and the limitation that the structure contains information as to how to use the storage structure, the inclusion of instructions is not considered to provide a patentable limitation on the claims because the instructions merely represent a statement of intended use in the form of instructions in a kit. See In re Ngai, 367 F.3d 1336, 70 U.S.P.Q.2d 1862 (Fed. Cir. 2004)(holding that an inventor could not patent known kits by simply attaching new set of instructions to that product).

Pierce teaches a finger print recorder. The finger print recorder of Pierce contains a sheet member (1) of transparent material with an adhesive coating (2). Specifically Pierce teaches the finger print recording is on a protected transparent record member by applying a piece of transparent sheet material coated with a suitable adhesive. A protective sheet of transparent material is applied to the adhesive coated side of the sheet to enclose the fingerprint thereon and provide a permanent finger print record that is an accurate reproduction of the original. Pierce suggests preserving the quality of the adhesive by keeping the adhesive applied to some surface to prevent it from collecting foreign matter. Pierce teaches that the tab may be indexed with any suitable information necessary to the recording and filing of the finger print recorder.

Pierce does not specifically teach using a backing sheet to protect the adhesive from foreign matter or a bar code for identification and recording of the fingerprint.

However, Draper teaches a form of identification material is printed on the substrate. The identification material comprises a machine readable bar code and identification number specifically to identify the biographical data, insurance information, and instructions (col. 3, lines 45-55). A device with a bar code provides a means to update all the information in an identical manner so that all pertinent information can be immediately and accurately assessed (col. 5, lines 25-33),

Moreover, Ballard teaches a self-contained fingerprint kit which comprises releasably secured sheets. Ballard teaches the release sheet is used to cover an adhesive and may be readily removed to expose the adhesive (col. 4, lines 25-35).

Therefore, it would have been *prima facie* obvious to the ordinary artisan at the time the invention was made to have modified the fingerprint structure taught by Pierce to allow for the identification and automated identification of the structure by adding a barcode to the structure and to have used a release liner to protect the adhesive prior to use. The ordinary artisan would have used a bar code or other non-functional printed matter on the fingerprint structure to allow for identification of the source in an easy, reliable manner. Using a bar code allows for automated identification of the structure as taught by Draper. Further, utilizing a backing sheet for the Pierce structure would protect the adhesive and allow for the use of permanent adhesive which when contacted to the base sheet could not be tampered with. The releasable sheet, taught by Ballard would be readily removed to expose the adhesive on the Pierce finger print structure and subsequently allow the security of the samples collected.

Response to Arguments

The response traverses the rejection. The response asserts that permanent adhesive would render pierce device inoperable for intended purpose. This argument has been considered but is not convincing because the claim requiring permanent adhesive, namely Claim 39, is not rejected in the rejection. Thus, the claims rejected are not limited to permanent adhesive. This argument is thus moot.

The response further argues that the backing sheet is not needed to protect adhesive. This argument has been reviewed but is not persuasive. Pierce teaches that the quality in the adhesive is to be kept on some surface to prevent it from collecting foreign matter. A backing sheet, as taught by Ballard is used to cover an adhesive and may be readily removed to expose the adhesive (col. 4, lines 25-35). All of the component parts were known in Pierce and Ballard and Draper. The only difference is the combination of the "old elements" into a single device by adding a backing sheet for protecting the adhesive. Thus it would have been obvious to one having ordinary skill in the art to add a backing sheet taught by Ballard onto the fingerprinting device as shown in Pierce, since the operation of a backing sheet would function to protect the adhesive. The combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

With respect to applicants response that there is no suggestion or teaching in the references to combine prior art, KSR forecloses the argument that a specific teaching, suggestion or motivation is required to support a finding of obviousness.

Thus for the reasons above and those already of record, the rejection is maintained.

8. Claims 33, 36, 38-39, 41, 44-46, 48-52, 54-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US Pat 6,162,485, December 2000) in view of Draper (US 6,007,104, December 28, 1999).

With respect to Claim 36 and the limitation that the structure contains information as to how to use the storage structure, the inclusion of instructions is not considered to provide a patentable limitation on the claims because the instructions merely represent a statement of intended use in the form of instructions in a kit. See In re Ngai, 367 F.3d 1336, 70 U.S.P.Q.2d 1862 (Fed. Cir. 2004)(holding that an inventor could not patent known kits by simply attaching new set of instructions to that product).

Chang teaches a finger printing system which comprises a transparent substrate with a reactive adhesive composition comprising a pressure-sensitive adhesive (col. 4, lines 1-5). The transparent substrate bearing the reactive adhesive is separated or peeled from said first substrate (col. 4, lines 41-45). This allows the visible image to be permanently protected by the transparent member which is adhered to the print-image forming area by the reactive adhesive. As seen in Figure 3A, 3B, 3C, the device comprises numerous layers for analysis. The device is a simple, defacement-proof fingerprinting system (col. 4, lines 65-66). Chang teaches that the substrate is paper (16) in Figure 2. The substrate (16) may be paper, plastic or the like (col. 9, lines 1-3)(limitations of Claim 38). Chang further teaches that the device comprises a release liner (26) which is attached by a reactive pressure-sensitive adhesive layer (28)(col. 9, lines 20-23)(limitations of Claim 41). The release liner is adhered to the substrate (16)

of the security document on the non-release side of the release liner (26) by means of a permanent laminating or non-pressure sensitive adhesive (30)(col. 9, lines 22-26). The transparent film (24) along with the pressure-sensitive adhesive (28) can be easily peeled away from the release liner. The transparent film may be polyethylene, polypropylene, for example (col. 10, lines 37-40)(limitations of Claim 54). The reactive pressure sensitive adhesive is preferably coated on the release surface (col. 10, lines 46-48). The device is used to image finger prints (limitations of Claims 44-46, 48-51). The device can contain additional absorbent materials for fingerprinting (see (32), (20), for example).

Chang does not specifically teach a bar code on the reverse surface to identify the biological sample.

However, Draper teaches a form of identification material is printed on the substrate. The identification material comprises a machine readable bar code and identification number specifically to identify the biographical data, insurance information, and instructions (col. 3, lines 45-55). A device with a bar code provides a means to update all the information in an identical manner so that all pertinent information can be immediately and accurately assessed (col. 5, lines 25-33),

Therefore, it would have been *prima facie* obvious to the ordinary artisan at the time the invention was made to have modified the fingerprinting system of Chang which uses identification by handwriting with a machine readable bar code of Draper. The ordinary artisan would have used a bar code or other non-functional printed matter on the fingerprint structure to allow for identification of the source in an easy, reliable

manner. Using a bar code allows for automated identification of the structure as taught by Draper.

Response to Arguments

The response traverses the rejection. The response asserts Chang and Draper do not teach or suggest all limitations of the pending claims. The response asserts that the Change device appears to be configured to that transparent film 24 and pressure-sensitive adhesive 28 can be peeled back from release liner 26 so that a biological sample can be placed between the adhesive and the release liner. This argument has been considered but is not convincing because the intended use of the product claim does not carry any patentable weight. The claims are directed to a product that has a base sheet, a transparent polymeric sheet secured to the base sheet, the transparent polymeric sheet comprises an adhesive and a backing sheet that is releasably secured to the transparent polymeric sheet and a bar code. The claims do not require any biological material in the device. The claims do not require any method steps, as the claims are to a product, which direct a user where to place a biological sample. The placement of a biological sample is not required by the instant claims. Thus, the structure of Change meets all of the limitations of the instant claims, but for a bar code which would have been obvious at the time the invention was made for the reasons of record.

The courts have held that "while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function." *In re Schreiber*, 128 F.3d 1473,

1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). In addition, “[A]pparatus claims cover what a device *is*, not what a device *does*.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). Therefore, the various uses recited in claims 33, for example, (e.g., the placement of a biological sample, not claimed) fail to define additional structural elements to the device of Claim 33. See MPEP § 2114.

Thus for the reasons above and those already of record, the rejection is maintained.

Conclusion

- 9. No claims allowable over the art.**
- 10. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jeanine Goldberg whose telephone number is (571) 272-0743. The examiner can normally be reached Monday-Friday from 7:00 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571) 272-0735.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The Central Fax Number for official correspondence is (571) 273-8300.



Jeanine Goldberg
Primary Examiner
August 20, 2007